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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,280	05/24/2001	Tsuyoshi Yamane	2001_0642A	9243

513 7590 01/22/2003

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EXAMINER
FULLER, ERIC B

ART UNIT	PAPER NUMBER
1762	7

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/863,280	YAMANE, TSUYOSHI	
	Examiner	Art Unit	
	Eric B Fuller	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *1 and 2* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-6* is/are rejected.

7)☒ Claim(s) *3-6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election of invention II, claims 3-6 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms that are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

The repeated phrase “toning color to reuse” is confusing in context.

The repeated phrase "separated and concentrated to store" is confusing in context.

The phrase "is not considered for changing paint color" is confusing (paragraph [0004]).

The phrase "if number of paint color of" is confusing (paragraph [0006]).

The phrase "the CCM system decreases number of using an original color paint" is confusing (paragraph [0020]).

The repeated phrase of "when two or more aqueous paint... are coated in the recycling system" is confusing. It is not understood how the paint is being coated, or what the paint is being coated with, in the recycling system.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 3-6 objected to because they contain the same informalities that have been mentioned for the specification. Appropriate correction is required.

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Specifically, claim 5 adds a limitation for "when two or more aqueous paints which belong to different groups...". As the claim is

open to comprise one color of paint and is drawn to a process, thus requiring limitations drawn to process steps, this claim fails to further limit the scope of claim 3.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-6 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regard as the invention. Evidence that claims 3-6 fail to correspond in scope with that which applicant regards as the invention can be found in paragraph [0007] of the specification. In that paragraph, applicant has stated that the object of the invention is to overcome problems associated with using two or more paints of different colors, and this statement indicates that the invention is different from what is defined in the claims because the claims are not limited to using two or more paints of different colors. As these claims read, the limitation of "when two or more aqueous paint having different paint colors... said aqueous paints, separated and concentrated to store" bares no patentable weight, as there is no positive recitation that the method requires two or more aqueous paints of different colors. These claims, as written, are open to methods having only one color of paint.

Claims 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, "the recycling system" lacks antecedent basis. Also, "coating an aqueous paint" is confusing, as it is not understood how the paint is being coated.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The literal translation has rendered these claims confusing. A search has been performed from the examiner's best understanding of the claims and supporting specification, however, clarification and correction is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (f) he did not himself invent the subject matter sought to be patented.

Claims 3-6 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. These claims are open to methods of single color aqueous paints. Applicant admits in paragraphs [0002-0006] that it is known to recycle these paints in a water-curtain-type coating booth and have the over-spray be collected and sent to a concentration tank that separates, by ultra filtration, the paint into concentrated paint and filtrate. The concentrated paint is stored and is re-prepared

before being reused. It is also taught in paragraph [0013] that computer-color-matching is a known method of re-preparing the concentrated paint.

Claims 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Spangler (US 5,684,053).

Spangler teaches a process where a water curtain collects the overspray of an aqueous paint in a spray booth (column 1, lines 14-25). When two or more types of paints are used, the collected overspray is segregated by color and type (column 2, lines 60-64) and separated into condensed paint and filtrate by use of ultra filtration (column 4, lines 59-67). The concentrated paint is stored until it is mixed with fresh liquid paint and reused in the process (column 5, lines 7-12). The filtrate is recycled back to the spray booths (column 3, lines 56-67). Since the water-curtains read on washing the spray booth, the filtrate being recycled reads on the limitations to claim 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spangler (US 5,684,053) as applied to claim 3 above, and further in view of Hayahara et al. (US 4,913,198).

Spangler teaches the limitations to claim 3 as shown above, but fails to teach using a computer-color-matching device to tone the reused paint. However, it is taught that during the separation processes, that the tone of the paint may be affected (column 4, lines 1-8). Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) of Spangler such that the color of the paint is easily and rapidly controlled.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kahmann et al. (US 6,037,010), Watanabe et al. (US 6,251,483 B1), Gross et al. (US 5,658,616), and Yamauchi et al. (US 6,497,751 B2) are all relied upon as being pertinent to the applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached at (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

EBF
January 15, 2003

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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